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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/559,895	12/06/2005	Michael Soukup	SOUKUP-PCT-US-1	2855
7590 12/11/2008				
OBER / KALER c/o Royal W. Craig Suite 800 120 East Baltimore Street Baltimore, MD 21202			EXAMINER CAILLOUET, CHRISTOPHER C	
			ART UNIT 1791	PAPER NUMBER
			MAIL DATE 12/11/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/559,895

Applicant(s)

SOUKUP, MICHAEL

Examiner

CHRISTOPHER C. CAILLOUET

Art Unit

1791

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 August 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SE/US)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Examiner: Caillouet

December 5, 2008

BUTTERFLY WING LAMINATION PROCESS AND METHOD OF USE

DETAILED ACTION

1. The amendment filed August 18, 2008 has been entered. Claims 13, 15, 17 and 19 were amended. Claims 7-9 were cancelled.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in prior Non-Final Office action mailed on March 18, 2008.

Claim Objections

3. Claim 16 is objected to because of the following informalities: Claim 16 recites, "a fourth layer of fixitive..." This appears to be a misspelling of the word "fixative." Appropriate correction is required.

Claim Rejections – 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 13-15 and 17-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claims 13 and 17 both recite the limitation "cutting ***precisely*** along an outer perimeter of said insect wing to separate said wing from a remainder of said

sheet;". It is unclear what "precisely along an outer perimeter" means or what tolerances from the actual wing that the cut may entail, such as, is any of the protective material left between the cutting tool and the butterfly wing as the cut is being made? Does the cutting tool make contact with the butterfly wing while making said cut along the precise perimeter said wing? Undue experimentation would be required for one to determine what tolerances are included with "precisely along an outer perimeter" in the limitation of the claims. Relevant prior art of Tandeau (FR 2784329) discloses cutting along the contour of the butterfly wing after it has been sealed between two protective layers (page 2, lines 2-21). The original disclosure cannot be used to support "precisely cutting" because the original disclosure states that the process contains a cutting step that cuts along the outer perimeter of the butterfly wing [Specification paragraph 0032]; since "cutting precisely" isn't specifically defined in the Specification, it cannot be added now.

6. Claim 13 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 13 recites the limitation, "applying a third layer of clear resin over said second layer of clear lacquer/resin." There is insufficient antecedent basis for the limitation of a second layer of clear lacquer/resin because the claim previously recites the limitation, "applying a second layer of **clear resin** over said first layer of clear lacquer/resin".

Claim Rejections – 35 USC § 103

7. Claims 13-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tandeau De Marsac (FR 2784329) in view of Deubel (US 2116752) and Okazaki et al. (US 6508013).

Regarding claims 13 and 16-19, Tandeau discloses a lamination process for insect wings comprising of: mixing a liquid epoxy resin; applying a layer of said epoxy resin (2) to a sheet of thin smooth material (1) (Figure 1; page 2).; affixing an insect wing (3) to said layer of liquid epoxy resin on said sheet (Id.); allowing said layer of liquid epoxy resin to dry (The examiner notes that it would be obvious to one of ordinary skill in the insect lamination art to allow any such layer, being an epoxy resin or fixative layer, to dry before further progress during a lamination process); applying a layer of adhesive (4) to the exposed side of the insect wing; and applying a sheet of thin smooth material (5) to the adhesive, enclosing and sealing the insect wing; cutting along an outer perimeter of said insect wing to separate said wing from a remainder of said sheet (Page 2, lines 2-21).

Tandeau does not disclose whether a fixative may be sprayed upon the butterfly wing nor does Tandeau disclose whether a layer of clear resin may be applied over the fixative. Deubel teaches a method of preserving butterflies for ornamental purposes (column 1, lines 27-35). Deubel teaches that an advantage to his method is that the delicate butterfly wings are protected and preserved from damage to the natural coloring of the butterfly wings by environmental factors (column 1, lines 20-26). Deubel teaches that a layer of fixative is applied to the butterfly to preserve the wings of

butterfly (column 1, line 52 - column 2 line 3), the butterfly with fixative layer is laminated to a thin smooth transparent material (Id.); any background material, such as a smooth transparent material, for the reverse side of the laminated wings is then applied to said reverse side (column 2, lines 4-10). Deubel further teaches that a clear resin may be used for covering the preserved wings, forming a coating through which the wings are clearly visible (column 2, lines 10-13). Deubel fails to disclose whether multiple coats of clear resin could be applied, but it is the position of the examiner that it would have been obvious through routine experimentation to one of ordinary skill in the art at the time of the invention to have repeated the resin applications in order to obtain desired decorative effects one wished to attain and to provide the necessary protection in order to preserve the butterfly wing.

It would have been obvious to one of ordinary skill in the art to modify the method of Tandeau by applying a fixative layer to the butterfly wings because one of ordinary skill in the art would recognize that the application of a fixative layer aids in preserving the wings of the butterfly during the lamination process as taught by Deubel (column 1, lines 52-57). Further, substituting the clear layer of material (5) of Tandeau with the clear resin layer of Deubel would have been obvious to one of ordinary skill in the art at the time of the invention because Deubel teaches that the clear resin layer is a functional equivalent of the clear layer of material used by Tandeau.

Furthermore, it would have been obvious to one of ordinary skill in the art at the time of the invention to use the clear resin layer of Deubel in the method taught by Tandeau because one of ordinary skill in the art would have been able to carry out such

a substitution to achieve the predictable result of providing a clear cover layer of material to view the coloring of the butterfly wings. "The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 82 USPQ2d 1385 (2007).

Okazaki et al. disclose a method of preserving a botanical specimen so as to preserve the beautiful color of the specimen (column 1, lines 8-18). Okazaki discloses that during the preservation process, a fixative is sprayed on the specimen (column 12, lines 54-62). Neither Deubel nor Tandeau teach that the fixatives or adhesives may be applied to the butterfly by a spray apparatus. It is the position of the examiner that using a spray apparatus to apply a fixative upon an object is well known in the art and would have been obvious to one of ordinary skill at the time of the invention as evidenced by Okazaki et al.

As to claim 16, a laminated wing disclosed by the above references combined.

As to claims 14-15 and 20, the method of claims 13 and 17 are taught as seen above. Tandeau teaches, further comprising the steps of: drilling a hole, through an end of said insect wing, and affixing a bail to said hole, wherein a preserved laminated insect wing suitable for use in all manner of jewelry results ([0004], lines 12-13). The examiner notes that the Tandeau invention can make jewelry ([0009], last line) and it would have been obvious to one of ordinary skill in the art to drill a hole and affix a bail to said hole in order to make a piece of jewelry.

Response to Arguments

8. Applicant's arguments with respect to claims 13-20 have been considered but are moot in view of the new ground(s) of rejection. Examiner will only address arguments that are pertinent to current rejection.

9. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). As stated in the rejection above, it would have been obvious to one of ordinary skill in the art to modify the method of Tandeau by applying a fixative layer to the butterfly wings because one of ordinary skill in the art would recognize that the application of a fixative layer aids in preserving the wings of the butterfly during the lamination process as taught by Deubel (column 1, lines 52-57). Further, substituting the clear layer of material (5) of Tandeau with the clear resin layer of Deubel would have been obvious to one of ordinary skill in the art at the time of the invention because Deubel teaches that the clear resin layer is a functional equivalent of the clear layer of material used by Tandeau.

In response to applicant's argument on page 7 of the Remarks that applicant's method allows one to cut exactly to the outer perimeter of the insect wing without rupturing the seal, the fact that applicant has recognized another advantage which

would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). Applicant argues that the methods of Tandeau and Deubel would not allow for one to form a seal along the edge of the wing of the butterfly and cut along said edge without rupturing said seal, as applicant's method would allow. As stated in the rejection above, Deubel teaches that a fixative is applied to the butterfly before it is attached to any transparent smooth material, which forms a seal and then applies a resin coating over the fixative. These are the same steps that applicant uses to form a seal, therefore, any cuts made in applicants method that do not rupture said seal would not rupture the seal in Deubel's method.

In response to applicant's argument on page 9 of the Remarks that Deubel fails to observe the color distortion problem that may occur when clear resins are applied directly to butterfly wings without first applying a fixative to said butterfly wings, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHRISTOPHER C. CAILLOUET whose telephone number is (571)270-3968. The examiner can normally be reached on Monday - Thursday; 9:30am-4:00pm, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Phillip Tucker can be reached on (571) 272-1095. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Christopher C Caillouet/
Examiner, Art Unit 1791

/Mark A Osele/
Primary Examiner, Art Unit 1791
December 8, 2008